UNITED STATES OF AMERICA,
Southern District of New York, ss.

I, Kenneth G. White, clerk of the circuit court of the United States of America for the southern district of New York, in the second circuit, do hereby certify that the writings annexed to this certificate are true copies of their respective originals on file and remaining of record in my office.

In testimony whereof, I have caused the seal of the said court to be hereunto affixed, at the city of New York, in the southern district of New York, in the second circuit, this [SEAL.] third day of December, in the year of our Lord one thousand eight hundred and fifty-eight, and of the independence of the said United States the eighty-third.

KENNETH G. WHITE, *Clerk.*

UNITED STATES OF AMERICA, *ss.*

The President of the United States of America to the Judge of the Circuit Court of the United States for the southern district of New York, greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said circuit court before you, or some of you, between Franklin Ransom and Uzziah Wenman, plaintiffs, and The Mayor, Aldermen and Commonalty of the city of New York, defendants, a manifest error hath happened, to the great damage of the said defendants, as is said, and as appears by their complaint, we being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the justices of the Supreme Court of the United States, at the Capitol, in the city of Washington, together with this writ, so that you have the same at the said place, before the justices aforesaid, on the first Monday of December next, that the record and proceedings aforesaid being inspected, the said justices of the Supreme Court may cause further to be done therein, to correct that error, what of right, and according to the law and custom of the United States, ought to be done.

Witness the Honorable Roger B. Taney, Chief Justice of the Supreme Court of the United States, this first Monday of December, in the year of our Lord one thousand eight hundred and fifty-seven, and of the independence of the United States the eighty-second.

[SEAL.]

KENNETH G. WHITE,
Clerk of the Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

The return to the writ of error herein appears in the schedules hereto annexed.

KENNETH G. WHITE, *Clerk.*

Filed Sept. 4, 1858.

Know all men by these presents, that we, The Mayor, Alderman and Commonalty of the city of New York, Daniel F. Tiemann, of the city of New York, paint dealer, and Edward Cooper, of the same city, street commissioner, are held and firmly bound unto Franklin Ransom and Uzziah Wenman in the sum of fifty thousand dollars, to be paid to the said Ransom and Wenman, their executors or administrators; for which payment, well and truly to be made, we bind ourselves, and each of us, jointly and severally, and our and each of our heirs, executors, and administrators, firmly by these presents.

Sealed with our seals, and dated the third day of September, in the year one thousand eight hundred and fifty-eight.

Whereas the above named, The Mayor, Alderman and Commonalty of the city of New York, have prosecuted a writ of error to the circuit court of the United States for the second circuit of New York, southern district, to reverse the judgment rendered in said circuit court in behalf of the said Ransom and Wenman against the said Mayor, Alderman and Commonalty:

Now, therefore, the condition of this obligation is such, that if the above named The Mayor, Alderman and Commonalty of the city of New York shall prosecute their said writ of error to effect, and answer all damages and costs if they shall fail to make good their plea, then this obligation shall be void; otherwise the same shall remain in full force and virtue.

DAN'L F. TIEMANN, *Mayor.*

DAN'L F. TIEMANN, [L. S.]
EDWARD COOPER. [L. S.]

Sealed and delivered in the presence of—
JAMES SANDFORD,

By the Common Council.

D. T. VALENTINE, *Cl'k C. C.* [L. S.]

I hereby approve of the firm and sufficiency of the preceding bond.

Dated New York, Sept. 4, 1858.

CHAS. A. INGERSOLL,
U. S. Dist. Judge.

UNITED STATES OF AMERICA,
State of New York, ss.

I, George W. Haichman, notary public in and for the State of New York, by letters patent under the great seal of said State, duly commissioned and sworn, dwelling in the city of New York, do hereby certify that the foregoing bond on writ of error was signed by the parties thereto, and by Dan'l Tiemann as mayor of New York, and that they each affirmed that they were severally worth the sum of fifty thousand dollars.

In witness whereof I have subscribed my name and caused my notarial seal of office to be hereunto affixed, the 3d day of September, A. D. 1858.

[L. S.]

G. W. HINCHMAN,
Notary Public.

UNITED STATES OF AMERICA,
State of New York, ss.

I, S. Myers, notary public in and for the State of New York, by letters patent under the great seal of said State, duly commissioned and sworn, dwelling in the city of New York, do hereby certify that David T. Valentine, of said city, being by me sworn, did depose and say, that he is the clerk of the common council of the city of New York; that the seal hereto affixed is the official seal of the city of New York, and was so affixed by their authority.

In witness whereof, I have subscribed my name and caused my notarial seal of office to be hereto affixed, the 3d day of Sept., A. D. 1858.

[SEAL.]

S. MEYER, *Notary Public.*

(*Endorsed:*)

Supreme Court of the U. S. In error. The Mayor, &c., New York, vs. Franklin Ransom and Uzziah Wenman. Bond on writ of error.

RICH'D BUSTEED,
Att'y for Pl'ffs in Error.

Approved.

CHAS. A. INGERSOLL.

Filed Sept. 4, 1858.

By the Honorable Charles A. Ingersoll, one of the judges of the Circuit Court of the United States, to Franklin Ransom and Uzziah Wenman:

Whereas the Mayor, Aldermen, and Commonalty of the city of New York lately issued out of the circuit court of the United States for the southern district of New York, in the second circuit, a writ of error directed to the judges of the circuit court of the United States for the southern district of New York, in the second circuit, stating, that in the record and proceedings, as also in the rendition of the judgment of a plea in the said court before the judge thereof, between Franklin Ransom and Uzziah Wenman, plaintiffs, and The Mayor, Aldermen, and Commonalty of the city of New York, defendants, a manifest error hath happened, to the great damage of the said defendants:

And whereas, for the correction of that error in due manner, the said writ has been issued, returnable at the next stated Supreme Court of the United States, to be held at the city of Washington, on the first Monday of December next: you are, therefore, hereby cited to appear before the said Supreme Court, at the city of Washington, on the said first Monday of December next, to do and receive what may appertain to justice to be done in the premises.

Given under my hand at the city of New York, in the southern district of New York, in the second circuit, the fourth day of September, in the year of our Lord one thousand eight hundred and fifty-eight, and of the independence of the United States the eighty-third.

CH'S A. INGERSOLL.

SOUTHERN DISTRICT OF NEW YORK,
City and County of New York, ss.

Andrew J. Campbell, of said city, being duly sworn, says, that on the 4th day of September, A. D. 1858, he served upon Uzziah Wenman, one of the plaintiffs in the above action, a copy of the foregoing original citation by delivering the same to him personally, and leaving the same with him at his house, in the city of Brooklyn.

ANDREW J. CAMPBELL.

Sworn to before me, this 3d day of Dec'r, 1858.

R. E. STILWELL,
U. S. Com.

SOUTHERN DISTRICT OF NEW YORK, *ss.*

Rich'd H. Bermingham, of the city of New York, being duly sworn, deposes and says, that on the 4th day of September, A. D. 1858, he served a copy of the foregoing original citation upon A.

P. Browne, esq., the solicitor for the plaintiffs in this action, by delivering the same to the said attorney personally at his office in the said city.

RICH'D H. BERMINGHAM.

Sworn to before me, this 4th day of Dec'r, 1858.

R. E. STILWELL,
U. S. Com.

Filed Sept. 4, 1858.

Circuit Court of the United States in and for the southern district of New York, in the second circuit.

Pleas before the Judges of the Circuit Court of the United States for the southern district of New York, in the second circuit, at the City Hall, in the city of New York, of the term of October, in the year of our Lord one thousand eight hundred and fifty-four: Kenneth G. White, Clerk; witness, Honorable Roger B. Taney, Chief Justice of the Supreme Court of the United States.

SOUTHERN DISTRICT OF NEW YORK, *ss.*

Franklin Ransom and Uzziah Wenman, of the said district, plaintiffs in this suit, complain of the Mayor, Alderman and Commonalty of the city of New York, defendants therein, being in custody, &c., of a plea of trespass on the case.

For that whereas heretofore, to wit, on the thirteenth day February, eighteen hundred and forty-one, letters patent of the United States, bearing date the day and year last aforesaid, signed by John Forsyth, Secretary of State, and countersigned by Henry L. Ellsworth, Commissioner of Patents, and bearing the seal of the Patent Office of the United States, were duly issued to Franklin Ransom and Uzziah Wenman, both of the city, county and State of New York, entitled for "a new and useful improvement in the mode of applying water to fire-engines, so as to render their operation more efficient," whereby was granted, according to law, to the said Franklin Ransom and Uzziah Wenman, their heirs, administrators or assigns, for the term of fourteen years from the said thirteenth day of February, eighteen hundred and forty-one, the full and exclusive right and liberty of making, constructing, using and vending to others to use, the said improvement, a description of which is given in the words of the said Franklin Ransom and Uzziah Wenman in the schedule annexed to said letters patent, and is made a part thereof, as by the record of the said original letters patent in the Patent Office of the United States, at Washington, will appear.

And the said Franklin Ransom and Uzziah Wenman, the plaintiffs, further aver, that afterwards, to wit, on the first day of Jan-

uary, A. D. 1854, and on sundry days and times before and afterwards, during the said term of fourteen years aforesaid, the said defendants, well knowing the premises, to wit, in New York, in the southern district of New York, did use, continued to use, and still do continue to use divers, to wit, one hundred fire-engines constructed on the plan patented by the plaintiffs as aforesaid, and in violation and infringement of the exclusive right so secured to the plaintiffs by said letters patent, and contrary to the form of the statute of the United States in such case made and provided, whereby the plaintiffs have been greatly injured and deprived of great profit and advantages which they might and would have otherwise made from said invention and letters patent, and have sustained actual damages to the amount of twenty thousand dollars, and by force of the statute aforesaid an action has accrued to them to recover such actual damages, and such additional amount not exceeding in the whole three times the amount of such actual damages as the court shall see fit to order and adjudge; yet the said defendants, though often requested, have never paid the same nor any part thereof to the plaintiffs, but have refused, and still do refuse, so to do, and therefore the plaintiffs bring this suit.

And now, at this day, that is to say, on the fifth day of December, as yet of the said October term, in the year of our Lord one thousand eight hundred and fifty-four, until which day the said defendants had leave to reply to the said complaint, and then and there to answer the same before the said judges of the circuit court of the United States aforesaid, at the City Hall, in the city of New York, in the southern district of New York aforesaid, and the defendants, the Mayor, Aldermen and Commonalty, by their counsel, come into court and defend the wrong, and say they are not guilty of the supposed grievances above laid to their charge, or any or either of them, or any part thereof, in the manner and form as the said plaintiffs have thereof complained, and of this they put themselves upon the country, and the said plaintiffs do the like, &c.

Therefore the issue above joined is ordered by the said circuit court to be tried at the circuit court for the southern district of New York, to be held at the City Hall of New York, on the first Monday of April next.

And now, at this day, to wit, on the eighteenth day of December, in the year of our Lord one thousand eight hundred and fifty-six, before the said judges of the circuit court of the United States for the southern district of New York, at the City Hall, in the city of New York, came the said plaintiffs, by their attorney, Alexander Porter Brown, and by their counsel, Charles M. Keller, esq., and Nathan K. Hall, esq., sitting as a judge of the circuit court of the United States for the southern district of New York, before whom the issue was tried, has sent hither his record in these

words, that is to say, on the day and at the place within contained, before Nathan K. Hall, esq., sitting as a judge of the circuit court of the United States for the southern district of New York, according to the form of the statute in such case made and provided, comes the within named plaintiffs, by their attorneys and counsel within named, and the within named defendants, by their attorneys and counsel, Wilcoxen and James W. Gerard, esqs. And upon the pleadings and proofs the cause was fully argued and by the court submitted to the jury who were called to try the issue between the parties. And after being duly tried and sworn, they do say upon their oaths, that the defendants are guilty of the several grievances within laid to their charge in the manner and form as the said plaintiffs have within complained against them; and they assess the damages of the said plaintiffs, by reason of the premises, over and above their costs and charges by them about their suit in this behalf expended, at twenty thousand dollars.

Therefore it is considered, that the said plaintiffs do recover against the said defendants their said damages, and costs and charges, by the jurors aforesaid in form aforesaid assessed, and also twenty-five hundred and eight dollars and ninety-four cents costs and charges by the said court now here adjudged, of increase to the plaintiffs, and with their assent, which said damages, costs and charges in the whole amount to twenty-two thousand five hundred and eight dollars and ninety-five cents.

And the defendants in mercy, &c.

Judgment signed this 25th August, 1858, for $22,508 94.

R. E. STILWELL, *Dep. Clerk.*

(*Endorsed:*)

U. S. Circuit Court, sou'n district of New York. Ransom & Wenman vs. The Mayor, Aldermen & Commonalty of the city of New York.

Judgment record. $22,508 94.

A. P. BROWNE,
Pl'ffs' Solicitor,
By CHAS. M. KELLER.

Filed Aug. 25, 1858.

United States Circuit Court for the southern district of New York.

Bill of Exceptions, to be tacked to or included in the record.

FRANKLIN RANSOM and UZZIAH WENMAN
against
THE MAYOR, ALDERMEN AND COMMONALTY OF THE CITY OF NEW YORK.

Be it remembered, that afterwards, on the eighteenth day of October, A. D. 1856, at a term of the circuit court of the United States for the southern district of New York, at the City Hall in

the city of New York, before the Honorable Nathan K. Hall, district judge of the United States for the northern district of said State of New York, and duly authorized to hold the circuit court for the southern district of New York, the issue of fact joined in this suit came on to be tried before the said judge, and a jury then and there duly empanelled to try the said issue.

After putting in evidence the letters patent and title papers, evidence was offered and put in on the part of the plaintiffs, tending to prove that the fire-engines purchased and paid for by, and belonging to the defendants, the corporation of the city of New York, prior to the date of the commencement of this suit, were constructed and worked substantially in accordance with the description in the letters patent in the declaration named.

It was conceded by defendants' counsel during the trial, that the said engines were purchased and paid for by the corporation of the city of New York, and that they were used for extinguishing fires in the said city.

Evidence was also put in on the part of plaintiffs, tending to prove that the invention set forth in the said patent in the declaration named was new and useful, and that by the use of the said invention fire-engines were rendered much more efficient; that water could be thrown to much greater height, and that with the same number of men, an engine on this plan could throw from three to four times the quantity of water which could be thrown with engines on any other plan; that on this plan forty men could work an engine for four or five hours, and throw a given quantity of water at a given distance, which two hundred men could not do without it; that fires could be and were extinguished by engines working on this plan, which could not be extinguished with engines working on any other plan; that the price of a fire-engine varies from $800 to $2,000; and that the said invention can be added to an engine of the ordinary construction for less than $25; that the number of engines belonging to the city of New York is from fifty to sixty, all working on this plan.

The plaintiffs then rested, and evidence was then offered and put in on the part of defendants tending to prove that plaintiffs were not the original and first inventors of the invention described and claimed in their said letters patent, and that in view of the admitted prior knowledge and use of certain pumps, it did not require invention to produce the combination specified and claimed by the plaintiffs in their said patent. And also tending to prove that the plaintiffs had not used reasonable diligence, after conceiving the idea of their said invention, in adapting, perfecting, and applying the same. And also tending to prove that the plaintiffs had knowingly permitted the defendants to apply and use their said patented invention after the grant of the said letters patent.

And after the defendants rested their case, evidence was then

offered and put in on the part of plaintiffs tending to prove that the plaintiffs had used reasonable diligence in adapting, perfecting, and applying their said invention to use and in making application for letters patent therefor; that an engine, constructed under their direction, was purchased by the corporation of the city of New York, as early as the month of June, 1840; that their application for letters patent was filed in the United States Patent Office on the 30th day of May, 1840, and the letters patent finally granted to them on the 13th day of February, 1841; that repeated applications had been made by plaintiffs to the defendants, from about the time of making application for the letters patent, for the adoption of the said invention, and after it was adopted, for compensation for the use thereof. And also tending to prove that the suggestions and experiments made by others with a view to the application of the principle of the invention described by plaintiffs in their said letters patent were unsuccessful, and abandoned as such, and that plaintiffs were the first to conceive the idea of the said invention, and the first to reduce it to successful practice. And also tending to prove that, with full knowledge of the various pumps proved to have been previously known and used, it required invention to produce the combination specified and claimed in the said letters patent of the said plaintiffs.

The judge in charging the jury said, among other things: "The fire-engine and peculiar character of its organization and construction are not claimed as the invention of the plaintiffs, nor do they claim as their invention any peculiar mode or form of construction of the close-pipe, or hose, which they claim to have been first to combine with the fire-engine, and connect with a hydrant, or water-pipe, so as to apply the principle of the hydrostatic pressure for the purpose stated; neither do they claim as their invention any peculiar device or arrangement for connecting the ends of this pipe or hose with the engine, and the hydrant or water-pipe. The fire-engine, and the suction-pipe or hose used with such engine-pipes of different materials, and hose of different kinds, were all well known and in common use for purposes similar to those to which they are now applied in the use of what the plaintiffs claim as their invention, and no one of these could have been separately the subject of a valid patent to the plaintiffs. But conceding this, the plaintiffs claim as their invention, and as secured to them by letters patent, the combination of the receiving tubes or pumps of a fire-engine, with a close-tube connecting such receiving tubes or pumps with an opening in a hydrant or pipe containing water, under such a degree of hydrostatic pressure as to make that pressure available to some extent, (the extent not being material,) in aid of the other power applied to the working of the fire-engine. The invention patented is, therefore, in my judgment, a combination of the pumps or receiving tubes of the fire-engine with a con-

necting pipe or hose, forming a connection between such engine and a hydrant or water-pipe, from which water is forced by the hydrostatic pressure existing in the hydrant or water-pipe into the pump or pumps of the engine, and applied so as to combine the power of this hydraulic pressure with the power applied to the brakes of the engine, substantially by the means and in the manner set forth in the plaintiffs' specification."

To so much of such statement and charge as is contained in the above sentence, commencing with the words, "The invention patented is," &c., and ending with the words "set forth in the plaintiffs' specification," and to every part thereof, the said defendants' counsel then and there excepted.

The judge, in further charging the jury, said: "The plaintiffs could not secure by letters patent the right to apply the hydrostatic pressure to the working of fire-engines in every mode and by every means which could possibly be devised for that purpose; they had a right to apply for, and the Patent Office had the right to grant, only a patent for the devices or means by which these parties proposed to make this hydrostatic pressure available for the purpose indicated in their specification; and having obtained a patent for these means and devices, they were protected against the use by other persons of those means or those devices, or any others which were substantially the same, or which were mere mechanical equivalents of those specified by the patentees, as the means which they used for the purpose of producing the effect desired. Then considering this to be the patent of the plaintiff—'the combination of the fire-engine with this connecting pipe or hose, by which the water is conducted from the hydrant or water-pipe into the works of the engine, and this hydrostatic pressure applied—it will be your duty, gentlemen, to determine whether in the first place it required invention, after the knowledge which the public had of the application of this principle in similar modes for the accomplishment of similar purposes, to produce the combination or arrangement, or what the plaintiffs call their invention as described in the specification annexed to the plaintiffs' patent. If with the knowledge which the public then had it required no invention, but simply the ordinary skill and ingenuity of the mechanic, to produce this combination—to produce these results; in other words, if the inventive faculty was not exercised, and was not needed to produce this alleged invention, then the patent would be void, because there was no invention to be secured to these patentees, and you have a right, in taking into consideration this question, to consider all the evidence which has been given in reference to the common pump, in reference to the pumps in use at the Fairmount water-works and the navy yard in Philadelphia, and then to say whether, with all the knowledge the public then had, it required invention upon the part of these plaintiffs to produce the combination and arrange-

ment which is described in their specification, so as to produce the results which they say they attain by their invention."

To so much of such statement and charge as is contained in the above sentence commencing with the words, "they had a right to apply for," &c., and ending with the words "producing the effect desired," and to every part thereof, the said defendants' counsel then and there excepted.

The said judge, further charging the jury, said: "If you are satisfied, gentlemen, that it required invention to produce this, you are then to inquire whether the plaintiffs were the original and first inventors or contrivers of this combination and connection; and if you are satisfied that the plaintiffs were not the original and first inventors or contrivers of this combination or connection, but that it had been used prior to their alleged invention, the plaintiff cannot recover in this action; in other words, if this invention had been previously made, if other parties had produced this combination, and had given to the public the benefit of their knowledge, so that these parties were not the first and original inventors, they cannot succeed in this action. In reference to the elements of this combination, gentlemen, the great and principal element is undoubtedly the fire-engine; and without that as one of the elements of the combination, this combination cannot exist. It is not therefore necessary that you should consider, upon this question of prior invention, the use of this principle in the pumps at the Fairmount waterworks or the navy yard, although you may refer to them upon the question whether invention was required to produce this arrangement; but upon the mere question of priority of invention, you need not refer to those in considering this case, because the principal and essential element in this combination being the fire-engine, the combination patented by the plaintiffs has never existed except in the cases in which that engine was used.

"In reference to the other elements of the combination, I feel it my duty to instruct you that the patent requires no particular mode of constructing this connecting pipe—it does not require that it should be a flexible hose, or an inflexible metallic pipe, and a pipe constructed like the ordinary suction pipe, and being to some extent flexible, secured against collapse when the supply of water becomes deficient, are equally within the plaintiffs' claim. There is nothing in the language of the specification, and it appears to me that there is nothing in the character of the invention itself, or of the purposes for which it was used, which render the use of a flexible hose essential and vital to the combination of the plaintiff. But it is enough for me to say in this connection, that, in my judgment, a flexible hose is not an essential and vital element of the combination; and therefore, for the purpose of making the combination indicated by the patent, it is not necessary that the flexible hose should be used to the exclusion of an inflexible tube,

of such a character as to allow the operation of this hydrostatic principle.

"Now I would say further, that in order to avoid the plaintiffs' patent, on the ground of want of originality, it is necessary that the jury should be satisfied that there was substantially the same combination and connection in the organization and arrangement which existed prior to the plaintiffs' alleged invention as is claimed as the invention of the plaintiffs, in the specification annexed to their patent; and as one of the essential elements of the combination so claimed is the fire-engine, no previous combination in which a fire-engine was not one of the essential elements can be substantially identical with the combination claimed by the plaintiffs as their invention; but the jury may take into consideration the manner in which this principle of hydrostatic pressure had been applied in the common pump, in the pumps of the water-works, and at the navy yard of Philadelphia, for the purpose of determining whether, after the application of the principle in those pumps and others, it required the genius of the inventor, in contradistinction to the ordinary skill and ingenuity of a competent mechanic, accustomed to the application of that principle in the construction of such pumps, and others in known and public use, to devise or make the combination and arrangement patented by the plaintiffs as the means of producing the intended result."

To all of which, and to each and every separate part and sentence of which, the said defendants' counsel then and there duly excepted.

The said judge, in further charging the jury, said: "If the plaintiffs are entitled to recover in this action, they are entitled to recover such damages as they have shown by their proofs have been actually sustained by them in consequence of the use of the invention patented without their license or consent, by the Fire Department of the city of New York. The amount of such damage does not depend upon the extent of the benefits accruing by means of such infringement to owners or insurers of property situated in the city; but the benefits accruing directly to the corporation in its corporate character, should undoubtedly form an element for consideration when the question of damages is reached, if it shall be reached by the jury. If the invention is valuable; if by its use the power and efficiency of the fire-engines belonging to the defendant are so increased, that fifty engines used with this improvement are equal in practical effect to seventy-five, or any other number of engines, used without this improvement, the jury are at liberty to infer, if they think the inference a just one, that the defendant, in its corporate capacity, has saved the cost of the purchase and operation of the additional number of engines which would have been required to produce the same results if this invention had not been used; and that the corporate authorities, if

they had admitted the plaintiffs' rights, would have paid the amount of this additional cost, or a large portion of it, as the consideration for a license to use this invention, rather than to abandon its use; and that the plaintiffs have therefore lost by the infringement what the defendant would have so paid to secure such license. It is for this reason that the benefits received by the defendant in its corporate capacity, from the use of the invention, in the consequent reduction of its expenditures for fire-engines, and their management and operation, are proper subjects for consideration in determining the plaintiffs' damages, and the jury must determine for themselves, upon the consideration of this and the other facts of the case, (if they find that the plaintiffs are entitled to recover,) what damages have been actually sustained by the plaintiffs in consequence of the unauthorized and wrongful acts of the defendant, being careful only to give the actual damages proved, and not to speculate upon the possibility or even probability of damages beyond such as are proved to have been sustained by the plaintiffs."

To all of which, and to each and every separate part and sentence of which, the said defendants then and there duly excepted.

The defendants then duly requested the said judge to charge the jury in accordance with each and every of the following points, or propositions:

I. The patent is for a law of matter—that is, the well known law of hydrostatic pressure, and is therefore void on its face.

II. It does not claim any machine or improvement on any machine, nor does it claim any new combination of old machinery.

III. It does not claim the mechanical means by which the hydraulic pressure is used, but the pressure itself, so that, no matter what mechanical means are used to introduce the pressure into the works of the engine, if the patent is good, any introduction whatever of hydraulic pressure would be an infringement upon the patent, which shows that the patent is void on its face.

IV. If the patent is not for what is stated in any of the previous propositions, then it is void on its face for vagueness and uncertainty.

V. The patent is void, taking its face in connection with the undisputed facts in the case.

VI. If using the hydraulic pressure through a flexible hose or pipe is the essence of the patent, then the patent is void for a defective specification, in not so stating.

VII. The patent does not claim the pipe or hose, through which the water is forced.

VIII. If it did, such a claim would not be patentable.

IX. If the plaintiff did not use reasonable diligence to perfect the invention after he conceived the idea, and in the meantime

other persons conceived the idea and practically applied it before he took out his patent, then his patent is void.

X. If the plaintiff knowingly allowed the application to be used by the public from the time he conceived the idea, to the time he took out his patent, it was a dedication to the public, and he cannot recover.

XI. From the undisputed facts of the case it appears, that the patentees knowingly allowed their claimed invention to be publicly used by individuals, commencing by themselves selling to the corporation the Farnham engine in 1840, before the date of the patent, and by the defendant, from the date of the plaintiffs' patent up to its expiration, and allowed engines to a great extent to be altered, and used upon that principle, and by those acts the patentees have abandoned their invention to the public, and are estopped from depriving the citizens of New York of the use of it, or from maintaining an action.

XII. If the judge declines to charge that the plaintiffs cannot maintain an action, for the reasons stated in the last proposition, then that he charge the jury that such is the law, if they find the facts so to be.

XIII. That from the facts stated in proposition XI, or if found by the jury as submitted in proposition XII, then that the plaintiffs can in no aspect of the case recover more than nominal damages.

XIV. The plaintiffs have furnished no data to estimate actual damages, and therefore in no aspect of the case can they recover more than nominal damages.

XV. By no patent obtained in 1841, in anticipation of the introduction of the Croton water into this city at the expense of millions of dollars, with great head arising from high reservoirs, and abundant supply of water, could the corporation be prevented from using their own water in their own hydrants, in such manner as they should find most available, especially as the precise mechanical arrangement had been known and used years before, in connecting the hydrants directly with the receiving tubes of the engines.

XVI. That "the Fire Department of the city of New York," whose members have infringed the alleged patent, is a body corporate and politic, capable in law of suing and being sued, in respect to the official acts of its members in the premises, and is the proper body to respond in this case.

XVII. That the relation of principal and agent in the legal sense of those terms does not subsist between the corporation and the firemen; that the corporation has had a public, political, and governmental duty cast upon it by the State in respect to the fire companies, which consists in the making of all needful rules and regulations for their government, and is unaccompanied by any private,

personal or pecuniary interest whatsoever, and that they, consequently, are not liable for the acts or omissions of the firemen.

XVIII. That in any view of the case the corporation is not liable in this case for the tortious infringement of the alleged patent by the firemen, because such tortious infringement thereof by the firemen was a departure from their legitimate duties, which does not appear by the evidence to have been authorized or sanctioned by any resolution or other valid act of the common council of the city.

XIX. That it appears from the evidence that the application as described in the patent—of the hydraulic pressure of water to assist in the working of pumps of the same construction as the pumps of fire-engines—has been in practical use in the Philadelphia navy yard, and at the Schuylkill water-works, long prior to the alleged invention of such application; that that use has been continuous up to the present time in the Schuylkill water-works, and that the patent is, consequently, void for want of novelty.

XX. The defendants request the judge to charge the jury, that from the undisputed facts in the case, they are bound to render a verdict for the defendants.

The said judge refused to charge as requested in respect to each of the first five of said points or propositions, and to the several refusals to charge as stated in each of said five points or propositions, the said defendants' counsel then and there duly excepted.

The said judge also refused to charge as requested by the said defendants in respect to the 6th of said points or propositions, but charged in regard thereto "that, using the hydraulic pressure thro' a flexible hose, or other flexible pipe, is not essential or necessary to an infringement of the plaintiffs' patent;" to which last mentioned refusal to charge, and also to such last mentioned charge, the defendants' counsel then and there duly excepted.

The said judge having already charged the jury as before stated in regard to the construction of the plaintiffs' patent, also refused to charge in the forms and language of the 7th and 8th of such points or propositions, or to charge or alter his charge in that respect; to which refusal to charge as to each of said last mentioned points or propositions the defendants' counsel then and there duly excepted.

The said judge also refused to charge as requested by the said defendants in respect to the said 9th, 10th, 11th, and 12th of said points and propositions, but charged in regard thereto, and to the matters there referred to, as following, viz: "If the plaintiffs did not use reasonable diligence to perfect the invention patented after the idea of it was first conceived, and in the meantime other persons not only conceived the idea, but perfected the invention, and practically applied it in public use before the invention of the plaintiffs had been so far perfected that it could be applied to practical use, the plaintiffs' patent is void, because they were not the first

and original inventors of the thing patented. And if the plaintiffs, after they had perfected their invention, unreasonably delayed their application for a patent, and other persons, before such application was made, actually perfected and applied the same invention to practical use, and gave the knowledge thereof to the public, and the plaintiffs, after the knowledge of such subsequent invention or discovery and its public use, failed to make objection, and to apply without unreasonable delay for a patent for their invention, they cannot sustain their patent, because they failed to give to the public that consideration for the grant of exclusive privileges upon which all valid patents must be based; and if the plaintiffs, after their invention was perfected, knowingly allowed it to be used in public for more than two years before they applied for letters patent, it is conclusive evidence of a dedication of such invention to the public, and their patent is void. And so also if the plaintiffs, after their invention was perfected, acquiesced in its use in public for a less term than two years without applying for a patent, and the jury shall be satisfied from such acquiescence, and the other facts of the case, that the plaintiffs in fact abandoned their invention, concluding not to patent it, but to dedicate it to the public use, they could not recall such dedication, or defeat such abandonment by a subsequent application for a patent, and their patent is, therefore, void.

"And if, after the plaintiffs had made this invention, (if they did make it,) they, in fact, deliberately abandoned it to the public use, and concluded not to patent it, if they dedicated it to the public use, no matter for what reason, then that dedication cannot be recalled, and they have no right to recover.

"If the plaintiffs, subsequent to the date of their letters patent, abandoned their invention to the public, and waived and abandoned the exclusive privileges intended to be secured by such patent, they cannot recover in this action, and the jury has a right to infer such an abandonment from their acquiescence in the use of the invention by others; their neglect to assert their claims by suit or otherwise; their omission to sell licenses to use such invention; their neglect to make efforts to realize any personal advantage from their patent; and similar circumstances, if they think the evidence establishes such fact of abandonment; and circumstances of that character may also be considered, in connection with the other evidence, upon the question of the originality of the plaintiffs' alleged invention; but if the jury are satisfied that the plaintiffs have not so abandoned their invention and privileges granted by the letters patent, their neglect to prosecute parties infringing such patent will not bar their right to recover such damages as they have actually sustained by the defendants' infringement."

To each of which refusals to charge in respect to each of said last mentioned points or propositions, and to each and every part and

sentence of said last mentioned charge, the said defendants' counsel then and there duly excepted.

The said judge also refused to charge as requested by the said defendants in regard to the said 13th, 14th, 15th, 16th and 17th points or propositions, to which refusals to charge in respect to each of said last mentioned points and propositions the said defendants' counsel then and there duly excepted.

The said judge also refused to charge as requested by the said defendants in respect to the said 18th point or proposition, but in respect thereto charged the jury that the defendants were so liable. "If the plaintiffs have sustained by their testimony the patent which they have given in evidence in this suit, it is conceded here by the counsel upon the part of the defendant, that the fire-engines used by the Fire Department are provided at the expense of the corporation; and although the Fire Department may be for certain purposes a distinct corporation, and possibly, to some extent, independent of the action of the corporation of the city, in its entire corporate capacity, yet if the plaintiffs have a valid patent in this case, and the firemen have used engines procured by the corporation, and that use has been without the consent of the plaintiffs, and in infringement of the plaintiffs' patent, the defendants are liable in this action, in consequence of the damage which the plaintiffs have sustained by reason of that infringement."

To which said last mentioned refusal to charge, and also to such last mentioned charge, the said defendants' counsel then and there excepted.

The said judge also refused to charge as requested by the said defendant, in respect to the 19th and 20th of said points and propositions, and to the refusal so to charge, in respect to each of such last mentioned points and propositions, the said defendants' counsel then and there excepted.

The jury having considered the case, rendered a verdict on the twenty-fourth day of October, A. D. 1856, in favor of the plaintiffs, and assessed their damages at twenty thousand dollars.

And inasmuch as the said several matters aforesaid do not appear by the record of the said verdict, the said defendants' counsel did then and there request his honor the said judge to put his seal to this bill of exceptions, containing the said several matters, and his honor the said judge did, in pursuance of such request, and of the statute in such case made and provided, put his seal to this bill of exceptions.

N. K. HALL. [L. S.]

Filed 11th Dec., 1858.